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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,974	11/19/2001	Jennifer L. Hillman	PF-0183-2 DIV	4346

27904 7590 10/03/2003

INCYTE CORPORATION (formerly known as Incyte
Genomics, Inc.)
3160 PORTER DRIVE
PALO ALTO, CA 94304

EXAMINER

YAEN, CHRISTOPHER H

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 10/03/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,974

Applicant(s)

HILLMAN ET AL.

Examiner

Christopher H Yaen

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,9-11,17-27 and 56-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-3,9-11,17-27 and 56-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1,2,17,18 and 56-59, drawn to an isolated polypeptide and a composition, classified in class 530, subclass 350
 - II. Claims 3, drawn to an isolated polynucleotide encoding a polypeptide of group I, classified in class 536, subclass 23.1.
 - III. Claims 9 and 10, drawn to a method of producing a polypeptide of group I, classified in class 435, subclass 69.1.
 - IV. Claim 11, drawn to an isolated antibody which binds to a polypeptide of group I, classified in class 530, subclass 387.1.
 - V. Claim 19, drawn to a method of treating a disease or condition comprising the administration of a composition of group I, classified in class 424, subclass 277.1, for example.
 - VI. Claim 20, drawn to a method of screening a compound for effectiveness as an agonist of a polypeptide of group I, classified in class 435, subclass 7.1.
 - VII. Claim 21, drawn to a composition comprising an agonist compound identified with the method of group VI, classified in class 530, subclass 300.

- VIII. Claim 22, drawn to a method of treating a disease or condition comprising the administration of the composition identified in group VII, classified in class 514, subclass 2.
- IX. Claim 23, drawn to a method of screening a compound for effectiveness as an antagonist of a polypeptide of group I, classified in class 435, subclass 7.21.
- X. Claim 24, drawn to a composition comprising an antagonist compound identified with the method of group IX, classified in class 530, subclass 317.
- XI. Claim 25, drawn to a method of treating a disease or condition comprising the administration of a composition of group X, classified in class 514, subclass 12.
- XII. Claims 26-27, drawn to a method of screening a compound that specifically binds to a polypeptide of group I, classified in class 435, subclass 7.23.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II, IV, VII and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions differ one from the other because the products have different structures, chemical properties, characteristics and are used for different purposes. For example the product of group I is drawn to a polypeptide

Art Unit: 1642

which is structurally, chemically, and functionally distinct from the polynucleotide and antibody of groups II and IV.

3. Inventions III, V, VI, VIII, IX, XI, and XII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions differ one from the other because the methods have different ingredients, steps, outcomes and are used for distinct purposes.

4. Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another means such as through peptide synthesis or purified from cellular extracts.

5. Inventions I and V, VI, IX, XII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used as an antigen to generate antibodies.

6. Inventions VII,X and VIII,XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1)

Art Unit: 1642

the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method of treating can be accomplished using anti-sense technology.

7. Inventions VI, IX and VII, X are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the compound can be screened using chromatography columns.

8. Inventions II, III, V, VI, VIII, IX, XI, and XII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions differ one from the other because the methods steps require the use of a compound unrelated to the product.

9. Because these inventions are distinct for the reasons given above and the search required for Groups I-XII are not require one for the other, and therefore restriction for examination purposes as indicated is proper.

10. Upon election of Groups I-VI, IX, and XII, Applicants are additionally required to elect a single Sequence identified by a specific sequence identification number, as indicated above as they apply to groups. The recited sequences have different structures one from other and the search for the sequences would be unduly

Art Unit: 1642

burdensome. This requirement is **not** to be construed as a requirement for an election of species, since each of the sequence(s) recited in alternative form is not a member of a single genus of invention, but constitutes an independent and patentably distinct invention.

11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 703-305-3586. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-305-3014 for After Final communications.

Art Unit: 1642

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Christopher Yaen
Art Unit 1642
September 29, 2003


ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1000